

Appl. No. 09/919,556
Amendment dated February 17, 2005
Reply to Office Action mailed November 17, 2004

REMARKS

Reconsideration is respectfully requested.

Claims 1 through 18 remain in this application. Claim 19 has been cancelled. No claims have been withdrawn or added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraphs 1 and 2 of the Office Action

The "provisional" double patenting rejection is acknowledged.

Paragraphs 3 through 6 of the Office Action

Claim 19 has been rejected under 35 U.S.C. §112 (first paragraph) as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention.

Claim 19 has been cancelled, and therefore the §112 (first paragraph) rejection of claim 19 is submitted to be moot.

Paragraphs 7 through 16 of the Office Action

Claims 1 through 4, 7 through 10 and 13 through 16 have been rejected under 35 U.S.C. §102(e) as being anticipated by Chen et al. (US 2003/0028650 hereinafter "Chen").

Claims 5, 6, 11, 12, 17 and 18 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Chen in view of Hall (US 2002/0138614).

In the rejections of all of the independent claims, claims 1, 7, and 13, Chen is relied on as teaching (in paragraph 9 of the Office Action):

... a method and apparatus for assigning internet protocol address comprising:

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identifying hosts present within a local network (see paragraph 76 on page 7);
providing a list of available features for at least one host within said local network (see paragraphs 79-80 on page 7 note the features are the type of connections available)/ analyzing a selected feature to be operable from said list (see paragraphs 79-80 on page 7); and
assigning an Internet protocol address to said at least one host, wherein a static Internet protocol address is assigned to said at least one host if said selected feature requires said static Internet protocol address (see figures 8 and 14 and paragraph 85 on page 8).

A "Declaration Under Rule 131" is submitted herewith "swearing back" of the Chen patent. The Chen patent has an effective filing date, i.e., an effective date as a reference, of July 23, 2001, only about eight days prior to the July 31, 2001 filing date of the present application. The Declaration clearly establishes conception of the claimed invention prior to July 23, 2001, and diligence for the short period from prior to July 23, 2001 to July 31, 2001, the filing date of the instant application, i.e., the date of statutory reduction to practice of the claimed invention. Thus, the Declaration effectively removes the Chen patent as a reference here.

Turning again to the rejections, there is, of course, no question that Hall alone fails to teach or suggest the invention as claimed. Thus, it is respectfully submitted that the rejections of claims 1 through 19 under 35 U.S.C. 102 (e) and 103(a) can be properly withdrawn.

Therefore, withdrawal of the §102(b) and §103(a) rejections of claims 1 through 18 is therefore respectfully requested.

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CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

LEONARD & PROEHL, Prof. L.L.C.

By



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Jeffrey A. Proehl (Reg. No. 35,987)
LEONARD & PROEHL, Prof. L.L.C.
3500 South First Avenue Circle, Suite 250
Sioux Falls, SD 57105-5807
(605)339-2028 FAX (605)336-1931